

**Remarks**

This Amendment is in response to the Office Action dated **March 14, 2007**.

Applicant acknowledges receipt of the priority papers. In the Office Action, the drawings were objected to under 37 CFR 1.83(a); claims 3, 8 and 12 were objected to because of informalities; claims 5 and 8 were rejected under 35 USC 112; claims 1-5 and 9-11 were rejected under 35 USC 102(b) as being anticipated by Fay (4,192,017); claims 6, 7 and 12 were rejected under 35 USC 103(a) as being unpatentable over Fay (4,192,017) in view of Bree (4,767,647) and claim 8 were rejected under 35 USC 103(a) as being unpatentable over Fay in view of Youmans et al (6,615,409).

The following comments are presented in the same order, with section headings, as the Office Action.

**Drawings**

In the Office Action, the drawings were objected to under 37 CFR 1.83(a) as failing to show every feature of the invention specified in the claims. Specifically, the imprinted foils injected into the plastic material must be shown or the feature canceled from the claims. Applicant has provided herewith a new Fig. 8 illustrating a representative foil that can be incorporated into the plastic material as recited in dependent claims 7 and 12. No new matter was added. Applicant has also amended the specification to incorporate a new paragraph between paragraphs [0034] and [0035] to discuss the Fig. 8. Support for this amendment can be found in paragraph [0016] as filed. No new matter has been added. Applicant requests withdrawal of the objection.

### **Claim Objections**

In the Office Action, claims 3, 8 and 12 were objected to because of informalities.

Applicant has added “and” to claim 3, as requested in the Office Action. Applicant has amended claim 8 into proper Markush format, as requested in the Office Action. Applicant has inserted “foils” into claim 12, as requested in the Office Action.

Applicant requests withdrawal of the objections.

### **35 USC 112**

In the Office Action, claims 5 and 8 were rejected under 35 USC 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Specifically, the Office Action asserts that claim 5 is indefinite because it is not clear what the phrase “is realized” is reciting. Applicant has amended claim 5. No new matter has been added.

The Office Action asserts that in claim 8, it is unclear what process is denoted by “incorporated” in the phrase “pigments are incorporated into the plastic material.” Applicant has amended claim 8 to recite “characterized in that the plastic material contains pigments.” No new matter has been added.

### **35 USC 102**

In the Office Action, claims 1-5 and 9-11 were rejected under 35 U SC 102(b) as being anticipated by Fay (4,192,017).

The Office Action asserts

With regard to the performance properties of the claimed plastic as recited in claims 1, 10, and 11, Applicant's claims recite a plastic hat part. Thus, any hat part formed from plastic is expected to perform in the same way as outlined by claims 1, 10, and 11.

Applicant disagrees with this broad assertion. Plastic polymers, like polyurethane, can be thermoplastic, as recited in independent claim 1, or thermoset, contrary to independent claim 1. Unlike thermoset polymers, thermoplastic polymers do not have permanent chemical bonds interconnecting the chains of the polymer together. Thus, a thermoplastic polymer, unlike a thermoset polymer, can be repeatedly softened by heating, molded to a new shape and then cooled to harden it, as discussed in the instant application. Therefore it is evident that a hat part formed from a thermoset plastic will not perform in the manner recited in independent claim 1, contrary to the assertion made in the Office Action that "any hat part formed from plastic is expected to perform in the same way as outlined by claims 1, 10, and 11." Furthermore, as discussed in the previous response, thermoplastic polyurethanes have a range of VICAT-softening temperatures outside the temperature ranges cited in independent claim 1.

The Office Action further asserts:

In order for the recited performance characteristics to be given patentable weight, these intended performance characteristics must result in a structural difference between the claimed invention and the structure disclosed by the prior art ... [because] the performance characteristics of the device do not carry patentable weight in an apparatus claim

Applicant disagrees with this *per se* rule asserted in the Office Action. The Federal Circuit Court of Appeals has stated that:

"[w]hile the measurement of a physical property may not of itself impart patentability to otherwise unpatentable claims,

when the measured property serves to point up the distinction from the prior art, or advantages over the prior art, that property is relevant to patentability, and its numerical parameters can not only add precision to the claims but also may be considered, along with all of the evidence, in determination of patentability” (*In re Glaug*, 62 USPQ2d 1151 (Fed. Cir. 2002) (citing *Pall Corp. v. Micron Separations, Inc.*, 66, F.3d 1211, 1216, 36 USPQ2d 1225, 1228 (Fed. Cir. 1995) and *In re Soni*, 54, F.3d 746, 750, 34 USPQ2d 1684, 1687 (Fed. Cir. 1995)).

Therefore, under *Glaug*, Applicant asserts that the limitations recited in independent claim 1 should be considered in the determination of patentability.

Despite Applicant’s disagreement with these assertions, Applicant has amended claim 1 to further prosecution. Claim 1 as amended recites “the hat part being deformed above the first temperature to a desired shape by a user of the hat.” Fay does not teach or suggest a hat part being deformed above the first temperature to a desired shape by a user of the hat. For at least this reason, Applicant requests withdrawal of the rejection and asserts that claims 1-5 and 9-11 are in condition for allowance.

### **35 USC 103 – Fay in view of Bree**

In the Office Action, claims 6, 7 and 12 were rejected under 35 USC 103(a) as being unpatentable over Fay (4,192,017) in view of Bree (4,767,647). As discussed above, Fay does not teach or suggest all the elements of independent claim 1 from which claims 6, 7, and 12 depend. The addition of Bree, which is asserted to teach an emblem formed from a decorative, embossed foil that is injected with a plastic material, does nothing to address the failure of Fay to teach or suggest all the elements of the instant claims.

For at least this reason, Applicant requests withdrawal of the rejection and asserts

that claims 6, 7 and 12 are in condition for allowance.

**35 USC 103 – Fay in view of Youmans et al**

In the Office Action, claim 8 was rejected under 35 USC 103(a) as being unpatentable over Fay (4,192,017) in view of Youmans et al (6,615,409). As discussed above, Fay does not teach or suggest all the elements of independent claim 1, from which claim 8 depends. The addition of Youmans, which is asserted to teach that it is known to provide numerous plastic lenses, including visors, with pigments incorporated into the plastic material, does nothing to address the failure of Fay to teach or suggest all the elements of claim 8. For at least this reason, Applicant requests withdrawal of the rejection.

**Conclusion**

Based on at least the above, Applicant respectfully submits that this application is in condition for allowance. Favorable consideration and prompt allowance of claims 1-12 is requested.

Should the Examiner believe that anything further would be desirable in order to place this application in better condition for allowance, the Examiner is invited to contact Applicant's undersigned representative at the telephone number listed below.

Respectfully submitted,

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